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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/728,439

12/05/2003

Scott A. Burton

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09/02/2008

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EXAMINER

RONESI, VICKEY M

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

09/02/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/728,439	Applicant(s) BURTON ET AL.	
	Examiner VICKEY RONESI	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-45, 48-50, 53-55, 58-60 and 75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-45, 48-50, 53-55, 58-60 and 75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/19/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/19/2008 has been entered.
2. All outstanding rejections, except for those maintained below, are withdrawn in light of applicant's response filed on 6/19/2008.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 103

4. Claims 7-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Highgate et al (US 4,768,503) in view of Asmus (US 5,270,358).

The rejection is adequately set forth in paragraph 5 of Office action mailed on 3/31/2008 and is incorporated here by reference.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Highgate et al (US 4,768,503) in view of Asmus (US 5,270,358) and further in view of Ahmed et al (US 6,458,877).

Art Unit: 1796

The rejection is adequately set forth in paragraph 6 of Office action mailed on 3/31/2008 and is incorporated here by reference.

6. Claims 19-39, 42-45, 48-50, 53, 55, and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Highgate et al (US 4,768,503) in view of Asmus (US 5,270,358) and further in view of Takemori et al (US 5,075,373).

The rejection is adequately set forth in paragraph 7 of Office action mailed on 3/31/2008 and is incorporated here by reference.

7. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Highgate et al (US 4,768,503) in view of Asmus (US 5,270,358) and Takemori et al (US 5,075,373) and further in view of Ahmed et al (US 6,458,877).

The rejection is adequately set forth in paragraph 8 of Office action mailed on 3/31/2008 and is incorporated here by reference.

8. Claims 1-4, 6, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Highgate et al (US 4,768,503) in view of Asmus (US 5,270,358) and further in view of Laurin et al (US 4,603,152).

The rejection is adequately set forth in paragraph 9 of Office action mailed on 3/31/2008 and is incorporated here by reference.

Art Unit: 1796

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Highgate et al (US 4,768,503) in view of Asmus (US 5,270,358) and Laurin et al (US 4,603,152) and further in view of Ahmed et al (US 6,458,877).

The rejection is adequately set forth in paragraph 10 of Office action mailed on 3/31/2008 and is incorporated here by reference.

10. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Highgate et al (US 4,768,503) in view of Asmus (US 5,270,358) and Laurin et al (US 4,603,152) and further in view of Yan et al (US 2003/0185889).

The rejection is adequately set forth in paragraph 11 of Office action mailed on 3/31/2008 and is incorporated here by reference.

Double Patenting

11. Applicant's statement on page 12 of the response filed on 1/8/2008 regarding the right to argue the patentable distinctness of the obviousness-type double patenting rejection over copending Application No. 10/728,577 upon identification of allowable subject matter. If the following double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

12. Claims 19-45, 48-50, 54, 58, and 60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-15,

Art Unit: 1796

17-19, 22-25, 77, 79, 82, 85-106, and 108-121 of copending Application No. 10/728,577 (published as US 2004/0180093).

US appl. '577 claims a wound dressing comprising a polymer composition prepared by combining an organic polymer matrix, a continuous hydrophobic liquid phase, hydrophilic polymer microparticles, and a bioactive agent selected from silver, copper, and zinc compounds. Even though US appl. '577 fails to claim a hydrophobic polymer as the matrix polymer, note page 2, lines 16-17, where US appl. '577 discloses the use of a hydrophobic matrix material that is continuous. Furthermore, note page 7, lines 7-9 where US appl. '577 defines that the continuous hydrophobic liquid phase is mineral oil. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970).

This is a provisional obviousness-type double patenting rejection.

13. Claims 7-45, 48-50, 58, and 60 are directed to an invention not patentably distinct from claims 2-15, 17-19, 22-25, 77, 79, 82, 85-106, and 108-121 of commonly assigned copending Application No. 10/728,577 (published as US 2004/0180093). Specifically, see the discussion set forth in paragraph 9 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned copending Application No. 10/728,577 (published as US 2004/0180093), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a)

Art Unit: 1796

if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Response to Arguments

14. Applicant's arguments filed 6/19/2008 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Highgate requires the composition to have sealing properties and therefore cannot read on the presently claimed "nonadherent" composition and (B) that there is no motivation to combine Highgate and Asmus because Asmus teaches an adherent composition.

In response, it is the examiner's position that "sealing" is not the same as "adhering." A seal ensures that the connection is tight, but one cannot presume because that the seal is bonded (as required by an adhesive) to the adjacent surface. For example, a gasket is used to seal a joint between two pipes to make it watertight but the seal could be easily removed when the mechanism holding the pipes in place is removed. Furthermore, even Highgate provides a

Art Unit: 1796

distinction between a seal and an adhesive by stating that adhesive properties can be imparted by adding a tackifier. There is no evidence on the record or in a dictionary that the terms “sealing” and “adhering” are necessarily equivalent. Even had Highgate taught the mandatory presence of a tackifier (and thus an adherent composition—which it does not), case law holds that the omission of an element and its function is obvious if the function of the element is not desired.

Ex parte Wu, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

With respect to argument (B), Asmus was relied upon to teach the usefulness of silver antimicrobial agents in biomedical articles. Given that both Highgate and Asmus are in the same field of endeavor (i.e., biomedical articles), it would have been obvious to one of ordinary skill in the art to combine the two with the relevant teachings by Asmus.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1796

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/27/2008

vr

/Vickey Ronesi/
Examiner, Art Unit 1796